



Paper No. 10

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OFFICE OF PETITIONS

In re the patent application of:
Forsyth, A., et al.
Application No.: 09/815,242
Filed: March 21, 2001
For: IDENTIFICATION OF ESSENTIAL GENES
IN PROKARYOTES

DECISION
ON PETITION

This is a decision under 37 C.F.R. 1.183, on a petition filed October 2, 2001 to waive the requirements of 37 C.F.R. §§ 1.52(b) and another petition filed May 10, 2002 to waive the requirements of 37 C.F.R. § 1.98(a)(2). The first petition seeks a waiver to file copies of the sequence listing on compact disc. The second petition seeks a waiver for filing a copy of the sequence listing for a PCT publication number WO 01/34809 and EP 0786519 in an Information Disclosure Statement (IDS) filed in the above-identified application.

The petitions under 37 C.F.R. § 1.183 to waive the rules in the above noted application is **GRANTED IN PART.**

There is no indication in the record why a sequence listing submitted on compact disc in the above identified application would fail to comply with 37 CFR § 1.52(e). Amendments to the material submitted on compact discs can be done by submitting replacement compact discs if the material to be submitted is permitted by § 1.52(e). See 37 CFR § 1.52(e)(4). The petition is Granted In Part to the extent that any amended sequence listing may be submitted by providing replacement compact discs rather than paper copies as provided in 37 CFR § 1.52(b).

37 C.F.R. § 1.98 requires applicants to submit as part of an IDS a legible copy of the portion of the reference that caused it to be included in the IDS. The size and method of publication of the sequence listing in PCT publication number WO 01/34809 and European Publication No. 0 786 519 makes it burdensome for applicant to submit, and for the Office to process if submitted, in the form it was published. Applicant and Michael Lewis of this office determined in earlier telephonic communications that the Office already has a copy of the sequence portion of the PCT and EP documents in a more usable form than applicant could submit.

Accordingly, it would be an unnecessary burden on both applicant and the Office to insist on a paper copy of the sequence portion of the PCT and EP documents.

The petition is Granted to the extent that no paper copy of the sequence portion of the PCT and EP references need be submitted with an IDS in this application.

After this decision is mailed, the application will be returned to the Technology Center 1600 for examination.

Telephone inquiries should be directed to Michael L. Lewis at (703) 306-5585.



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